

Remarks:

Applicant has carefully studied the non-final Examiner's Action mailed 11/13/2003, having a shortened statutory period for response set to expire 02/13/2004. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings and numbered paragraphs that correspond to the centered headings and paragraph numbering employed by the Office, to ensure full response on the merits to each finding of the Office.

Drawings

1. The objection to the drawings is not understood. There is no difficulty in relating Figs. 1 and 2 to Figs. 3-7 and the structure depicted in Figs. 1 and 2 is not a completely different invention. Applicant therefore speculates that perhaps the Office file of this application includes a different Fig. 1 and 2 than the Figs. 1 and 2 that were filed by Applicant. This concern is further amplified by the comments of the Office in paragraph 2 of the outstanding Office action.

Applicant called the Office to request a copy of Figs. 1 and 2 as they appear in the Office's file and the Office responded by faxing to Applicant Figs. 1 and 2 from an unrelated patent application. Attached hereto are Figs. 1 and 2 as electronically filed by Applicant on 8/13/2003, together with a Declaration of Facts and together with a Applicant's file copy of said drawing sheet (which file copy includes a chopped-off right margin due to the way the Office's software works). Note that the upper right hand corner of Applicant's file copy of Figs. 1 and 2 says "Page 12 of 14" which is consistent with the rest of the papers filed. Also note at the bottom of Applicant's copy of said Replacement Sheet is the following notation:
file:///E:/Shared/1506_01/Specification-trans.xml which is consistent with the remaining sheets of the application as electronically filed. Finally, note on the lower right-hand corner of Applicant's file copy of said Figs. 1 and 2 the notation "8/13/2003" which is also consistent with all of the other pages filed at the time the application was electronically filed.

It follows that Applicant, using software provided by the Office, filed this application correctly. By some unknown mix-up in the Office's software, the first page of drawings in an unrelated application were inserted into Applicant's application.

Accordingly, the Office is requested to substitute the attached Replacement Sheet for the drawing currently in the Office's file. There are two reasons why the attached Replacement Sheet does not represent new matter.

First, if the Office will examine its electronic files, it will discover that the attached Replacement Sheet was in fact electronically filed by Applicant along with the remaining pages of the application. It might be helpful to examine the files of the case from which the unrelated drawings came because the original drawings on the Replacement Sheet may have somehow become switched with the drawings in said unrelated application.

Second, the Replacement Sheet does not introduce new matter because all of the structure depicted in the Replacement Sheet is also depicted in the drawings sheets received by the Office, or discussed in the specification.

2. The drawings stand objected to because the reference numerals 30(a), 30(b), 30(c), and 30(d) appear in the drawings but not in the specification. Applicant has carefully studied the drawings that were filed and no such reference numerals appear in said drawings. Accordingly, Applicant has concluded that the Office has in its possession a different set of drawings than the set of drawings that was filed. The Replacement Sheet includes those reference numerals.

Claim Objections

3. Claim 1 stands objected to because of the term "adapted to" in lines 1, 5, 13 and 16. Accordingly, claim 1 has been carefully amended to delete the "adapted to" terminology. However, to protect the record against unwarranted prosecution history estoppel, Applicant confirms that said "adapted to" terminology was not intended as a positive limitation but was used in the traditional sense of identifying structure that forms no part of the invention, *per se*. For example, a future infringer of Applicant's patent rights might sell the hollow housing of this invention without the conduit received within the lower end of said hollow housing. Thus claim 1 in its original form recited that the hollow housing is adapted to receive a conduit. Similarly, said infringer would not sell the exterior surface of a wall against which the hollow housing is adapted to abut nor would said infringer sell the elongate cable received within the lumen of the conduit. Thus, claim 1 in its original form recited that the hollow housing was adapted to abut the exterior surface of the wall and that the lumen was adapted to receive an elongate cable. Therefore, as currently amended, claim 1 shall be construed as if the "adapted to" terminology

had not been deleted therefrom because the deletion of such terminology was not made to overcome any prior art reference.

Claim Rejections – 35 USC § 103

4. Applicant acknowledges the quotation of 35 U.S.C. 103(a).

Claims 1 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan (US 3,809,798) (*sic*: 4,366,344) in view of Beinhauer (US 4,431,198). Reconsideration and withdrawal of this ground of objection is requested for the reasons that follow.

Sheehan does not provide a device that covers a throughbore formed in a wall. Nor does the Sheehan device abut a wall. The Sheehan device is clipped to an electrical junction box. The Office asserts: "Sheehan lacks a port formed in said closed top adapted to receive a sealant that at least partially fills said hollow housing to seal said throughbore." However, Sheehan does disclose a port. The last four (4) lines of column 2 of Sheehan recite as follows:

The bight portion of the connector has a small hole 47 through which the red plug is visible so that upon inspection it can be seen that the metal shield has projected far enough into the connector.

Thus, Sheehan teaches away from an opening into which a sealant may be introduced. Sheehan teaches that an opening should be provided to enable visual inspection of the interior of the connector. Applicant has clearly not followed the teaching of Sheehan.

Applicant acknowledges that claim 1 stands rejected as being unpatentable over the combination of Sheehan and Beinhauer, not just Sheehan alone. It is instructive to note, however, that Sheehan teaches an opening that is *not* to be used as a sealant access opening whereas Beinhauer teaches a sealant opening but only in a split collar device having "elongate foam exit slit 26" (col. 2, line 53). The expandable foam introduced into Beinhauer's opening 24 therefore completely fills the Beinhauer split collar and escapes therefrom through said elongate foam exit slit 26 so that the foam surrounds the outside of the split collar and fills opening 14 in bulkhead 10 as depicted in Fig. 4.

Beinhauer's teaching of an expandable foam and a structure having a foam exit slit teaches away from Applicant's invention as claimed.

Moreover, Beinhauer does not teach or suggest a hollow housing having a sealant injection port but lacking a sealant exit port. In acknowledgement of the fact that Sheehan teaches an opening into which no sealant may be introduced and Beinhauer teaches an opening into which an expandable foam may be introduced but only in the context of an accompanying exit opening through which the foam may expand to fill external spaces, it follows that no combination of Sheehan and Beinhauer teaches or suggests a sealant opening in a hollow housing having no exit openings so that an elongate member within said hollow housing is surrounded by said sealant and so that the environment external to said hollow housing is not occupied by said sealant.

5. Claim 2 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan in view of Beinhauer as applied to claim 1, and further in view of Moore et. al., hereinafter referred to as Moore.

Reconsideration and withdrawal of this ground of rejection is requested for the reasons that follow.

Neither sealant nor an expandable foam is introduced into the Moore structure. Instead, an electrical conductive material such as "shots, granules, powder, grease, liquid or a combination of these....The conductive material 42...must provide an electrical path from the shield of each cable to housing 14." (col. 4, lines 40-49).

The use of such an electrically conductive material also teaches away from Applicant's sealant. Plugs 51 and 52 of Moore must be made of an insulating material to protect those who might contact such plugs from the electrical current carried by the conductive material within the Moore housing. This clearly teaches away from Applicant's invention as claimed.

Allowable Subject Matter

6. Claims 3-5 stand objected to as being dependent from a rejected base claim, but in condition for allowance is rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully declines to amend claim 1 by adding to it the limitations of claims 2 and 3 because Sheehan, Beinhauer and Moore teach away from the invention as now claimed in claim 1, currently amended. Restricting the invention to

the first and second flanges, each of which having a screw-receiving aperture formed therein, would overly limit the invention in view of the limitations of the prior art as pointed out in paragraphs 4 and 5 hereof.


Conclusion

7. Applicant agrees that the art made of record and not relied upon is not more pertinent to the claimed invention than the art cited and relied upon.

8. If a Notice of Allowance cannot be entered at this time for any reason, a telephone call to the undersigned at (727) 507-8558 is requested. Applicant thanks the Office for its careful and astute examination of this important patent application.

Very respectfully,

SMITH & HOPEN

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Dated: February 11, 2004

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CERTIFICATE OF FACSIMILE TRANSMISSION
(37 C.F.R. 1.8)

I HEREBY CERTIFY that this Amendment A, including Amendments to the Claims, Amendments to the Drawings, and Remarks, is being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 2831, Attn: Angel R. Estrada, (703) 872-9318 on February 11, 2004.

Dated: February 11, 2004



Deborah Preza